

Hearing:
March 16, 1999

Paper No. 32
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 10/28/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Frederick's of Hollywood, Inc.
v.
Freddi Q International, Ltd.

Opposition No. 102,183
to Application No. 74/607,193
filed on December 5, 1994

Richard D. Slehofer, Esq. for opposer.

Charles P. Kennedy of Lerner, David, Littenberg, Krumholz &
Mentlik for applicant.

Before Hohein, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Frederick's of Hollywood, Inc. has filed an opposition
to the application of Freddi Q International, Ltd. to
register the mark FREDERIQUE for numerous items of women's

clothing¹ and children's clothing,² in International Class 25.³

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks, as indicated below, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

FREDERICK'S and FREDERICK'S OF HOLLYWOOD

for: "aprons, gowns, lingerie, blouses, boas, bodyshirts, bodysuits, boots, brassieres, briefers, chemises, coats, cover-alls, corsets, culottes, dresses (women's and girls'), dusters, foundation garments, fur capes, fur coats, fur neck pieces, fur pieces, garter belts, garters, girdles, half slips, hosiery, housecoats, jackets, jerseys, jumpsuits, nightgowns, pajamas, panties, pantsuits, panty hose, paste-on bras, peignoir sets, petticoats, playsuits, robes, shirts, shoes, shorts, skirts, slacks, slippers, slips, stoles, suits, sweaters, swimsuits,

¹ The women's clothing items identified in the application are blouses, evening dresses, shirts, skirts, hot pants, shorts, boxer shorts, pants, slacks, bodysuits, parkas, coats, sweaters, jackets, dresses, pantsuits, sleepwear, stockings, socks, coveralls, jumpsuits, nightgowns, pajamas, robes, jerseys, bathing suits, swimwear, cover-ups, sarongs, blazers, sports jackets, jeans, underwear, lingerie, panties, pantyhose, T-shirts, bralets, brassieres, foundation garments, garters, slips, chemises, warm-up suits, sweat suits, jogging suits, jogging bras, leotards and tights.

² The children's clothing items identified in the application are bathing suits, swimwear, jeans, skirts, sweaters, slacks, shorts, shirts, T-shirts.

³ Application Serial No. 74/607,193, filed December 5, 1994, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods. The application includes the statement that the name "Frederique" identifies applicant's president.

undershorts, and waist cinchers," in International Class 25⁴; and

for: "retail store and mail order services in the fields of clothing, personal items, cosmetics and toiletries, pharmaceuticals and exercising equipment and aids," in International Class 42⁵; and

for: women's and girls' dresses, skirts, blouses, sweaters, coats, jackets, jerseys, petticoats, slacks, shorts, shirts, brassieres, corsets, girdles, foundation garments, slips, half slips, panties, garter belts, stoles, fur coats, fur neck pieces, fur capes, shoes, slippers, suits, hosiery, nightgowns, pajamas, robes, peignoirs, coveralls, house coats, chemises, dusters, swimsuits, and playsuits; men's shirts, shorts, overalls, undershorts,

⁴ Respectively, Registration No. 1,058,525, issued February 8, 1977 [sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed for a period of ten years from February 8, 1997]; and Registration No. 1,674,329, issued February 4, 1992 [sections 8 and 15 affidavits accepted and acknowledged, respectively]. Registration No. 1,058,525 includes in its identification of goods the following additional items: "pant sets," "shirts (men's and boy's)," and "theatrical clothes."

⁵ Respectively, Registration No. 1,051,548, issued October 26, 1976 [sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed for a period of ten years from October 26, 1996]; and Registration No. 1,627,771, issued December 11, 1990 [sections 8 and 15 affidavits accepted and acknowledged, respectively].

swimsuits, jackets, sweaters, suits and pajamas;
boys' shirts, jackets, slacks, swimsuits, and
sweaters, in U.S. Class.⁶

Applicant, in its answer, admitted opposer's ownership of its pleaded registrations, but denied the remaining salient allegations of opposer's claim. Applicant asserted affirmatively that its mark identifies "the world famous model Frederique van der Wal" and, thus, has "a different connotation and overall meaning" from opposer's pleaded marks; and that there has been contemporaneous use of the parties' marks with no actual confusion.⁷

The Record

The record consists of the pleadings; the file of the involved application; certified status and title copies of opposer's pleaded registrations; by consent of the parties, a copy of the file of opposer's pleaded Registration No. 664,746 and copies of third-party registrations⁸; copies of

⁶ Registration No. 664,746, issued July 22, 1958 [sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed for a period of ten years from July 22, 1998].

⁷ While these averments have been titled as "affirmative defenses" they are considered merely statements in support of applicant's denial of opposer's claim. Applicant also asserted, as an affirmative defense, that the notice of opposition fails to state a claim upon which relief can be granted. We consider this merely part of applicant's denial, since no motion to dismiss was filed and, in any event, opposer's notice of opposition adequately states a claim of likelihood of confusion under Section 2(d).

⁸ Applicant also submitted a print-out of information regarding a third-party registration from a non-Patent and Trademark Office (PTO) database. While this is usually inadequate evidence of a third-party registration, as opposer did not object and appears to have treated it

articles and advertisements from magazines and newspapers and excerpts from news services, all submitted by the parties' notices of reliance; opposer's answer to applicant's Interrogatory No. 27, submitted by applicant; the testimony deposition by opposer of Robert R. Genest, opposer's president, department of retail stores, with accompanying exhibits; and the testimony deposition by applicant of Frederique van der Wal, applicant's president, with accompanying exhibits.

Opposer also submitted copies of its annual reports for several years and a declaration by George W. Townson, opposer's president and CEO. Applicant objects to Mr. Townson's declaration in the absence of an agreement between the parties; and applicant objects, on the ground of hearsay, to consideration of the financial and sales information contained in the annual reports, contending that opposer has not adequately established them to be business records. Both of applicant's objections are well taken. Trademark Rule 2.123(b) specifically provides that testimony may be submitted by affidavit **only** by written agreement of the parties. *See also TBMP § 716; and Hilson Research Inc. v. Society for Human Resource Management, 27*

as being of record, we have so considered it for whatever evidentiary value it may have.

USPQ2d 1423, 1425 at n. 8 (TTAB 1993). Thus, we have not considered Mr. Townson's declaration. Regarding the annual reports, such reports are not admissible, and have not been considered, for the truth of the statements contained therein.⁹ However, Mr. Genest's testimony contains statements regarding opposer's advertising and sales figures and opposer has adequately established that these statements are based on Mr. Genest's knowledge in his official capacity. Therefore, we have considered such statements to be part of the record.

Both parties filed briefs on the case and an oral hearing was held.

The Parties

The evidence establishes that, since 1946, opposer has operated retail stores and a large mail order business selling men's and women's clothing exclusively under its own "Frederick's of Hollywood" brand. Opposer's logo, used since at least 1986, appears *inter alia* on all of its store signs and clothing labels, and is shown below:

⁹ We note opposer's attorney's statement, in connection with Mr. Genest's deposition, that the annual reports were not introduced for the accuracy of the figures contained therein.

Opposer's retail stores and extensive mail order business are identified, both by opposer and third-parties, principally as "Frederick's of Hollywood" and, occasionally, as "Frederick's." Opposer's business was founded by Frederick Mellinger, with its first store being located in Hollywood, California. Opposer now has approximately 200 stores throughout the United States, and many of its stores are located in shopping malls. Opposer's Hollywood location remains opposer's flagship store and includes a lingerie museum.

Opposer's catalogs feature both men's and women's clothing and include a wide range of women's clothing, although a substantial portion of each catalog is devoted to lingerie and "sexually suggestive" and/or "romantic" attire. Opposer's witness, Robert Genest, acknowledged that "sexually suggestive" and/or "romantic" attire is a specific niche market. Mr. Genest indicated that opposer's primary competitors include Victoria's Secret, department stores and small boutiques.

Mr. Genest testified that opposer has a catalog subscriber list of two million customers, and that opposer mails approximately 51 million catalogs during a one-year period. Mr. Genest stated that opposer's combined retail and mail order sales for 1996 were \$48 million, noting that

mail order sales through its Internet web site alone totaled almost two million dollars in a one year period; and that its advertising expenses for 1996 were \$23,867,000 for the mail order division and \$854,000 for the retail stores.

Opposer submitted numerous excerpts of articles from magazines and newspapers, particularly the *Los Angeles Times*, which refer to opposer, almost unanimously, as "Frederick's of Hollywood" and either are about opposer's business or contain a reference to opposer, usually in connection with sexually suggestive attire.

Applicant principally markets and licenses the name and persona of Frederique van der Wal in connection with a variety of clothing and cosmetic products. Ms. van der Wal is a model who began modeling in the United States for the Elite Agency in 1987. She is known professionally as "Frederique." Ms. Van der Wal has been featured in advertising campaigns for Guess Jeans, Revlon, and Victoria's Secret; she has appeared on numerous magazine covers, including *Cosmopolitan*, *American Vogue*, *Mademoiselle*, *Harper's Bazaar* and *Elle*; and appeared in television commercials advertising the products or services of Revlon, L'Oreal, MCI, Visa, Master Card, Diet Coke and Michelob. Ms. van der Wal testified that she has appeared

on the television shows of Oprah Winfrey, David Letterman and Jay Leno, and she has been featured on Access Hollywood. Ms. van der Wal stated that she recently began an acting career and is presently acting in several movies. As an actress, Ms. van der Wal identifies herself by her full name, although she noted that the press continues to refer to her as "Frederique."

In connection with her name "Frederique," Ms. van der Wal marketed a swimwear line ("Freddi Q by Frederique"), in 1994 and 1995, and a fragrance line ("Frederique" and a stylized "F"), beginning in 1994. She participated in advertisements and promotions for these products. In 1995, applicant began shipments to J.C. Penney of a "Frederique" line of lingerie, sleepwear and loungewear. Sales have been minimal in recent years. Hang tags and advertisements for this line include both the name, "Frederique," and Ms. van der Wal's photograph. Applicant recently began selling a line of clothing, principally sleepwear, under the name "Frederique," through the QVC television shopping network.

Analysis

Inasmuch as certified copies of opposer's pleaded registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice*

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations in this case are the similarities between the marks, the similarities between the goods and services, the channels of trade, and the class of purchasers. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

With respect to the goods and services of the parties, we observe that there is a substantial overlap in the goods identified in the application and the goods in the pleaded registrations. Further, applicant's identified goods are closely related to the retail and mail order services identified in opposer's registrations. Opposer's services feature clothing and some of the featured clothing is the same as or similar to the type and category of clothing identified in the application. Thus, we conclude that applicant's goods and opposer's goods and services are either identical or closely related.

Applicant's comments about the specific nature of opposer's clothing are unavailing as both applicant's identification of goods and opposer's identifications of goods and services are broadly worded. Similarly, neither party's identification of goods or services contains any limitations as to channels of trade or classes of purchasers. We must presume that the goods of applicant and the goods and services of opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods and services of the types identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we conclude that the channels of trade and classes of purchasers of applicant's goods and opposer's goods and services are the same.

Turning to the marks, we note that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Further, while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing

improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this regard, opposer contends that FREDERICK'S and FREDERIQUE are "indistinguishable in pronunciation" and "strikingly similar in appearance and meaning"; and that its marks have become famous in connection with the identified goods and services.

Applicant contends, on the other hand, that the marks are different in that "Frederique," in particular, is an unusual feminine first name of French origin and it is associated with Ms. van der Wal; that "Frederick" is a common masculine first name and it is associated with opposer's founder; that the two names are pronounced differently; and that "Frederick" appears in both of opposer's marks in the possessive form. Applicant contends, further, that FREDERICK'S is a weak mark¹⁰; and

¹⁰ Applicant's comments regarding opposer's alleged lack of use of the mark FREDERICK'S are not relevant to our consideration, in view of the valid and subsisting registrations for this mark. Applicant's comments constitute, essentially, an attack on the validity of opposer's registrations for the mark FREDERICK'S. These allegations will not be entertained since applicant has not filed a counterclaim for cancellation of those registrations.

that FREDERICK'S OF HOLLYWOOD and FREDERIQUE engender entirely different commercial impressions. In support of its position that FREDERICK is a weak component of a mark, applicant submitted copies of third-party registrations for the following marks in connection with, *inter alia*, clothing: CHESTER FREDERICK, FREDERICK & STONE, FREDERICK THEAK, FREDERIC CASTET and FREDERIC FEKKAI.

Applicant concedes that opposer's mark FREDERICK'S OF HOLLYWOOD is "well known" in connection with the identified goods and services. While the evidence supports this conclusion, we find that opposer has not established that its FREDERICK'S OF HOLLYWOOD mark is famous and, thus, entitled to a wide latitude of legal protection.¹¹ See, *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992). Based on the record before us, we further agree with applicant that the reputation

¹¹ The record includes information about the financial success of opposer over a period of years, gross earnings and advertising expenditures for several years, catalog subscription lists, and references to opposer in the press. However, the record lacks information about opposer's business or the industry in general from which we can determine whether opposer's products and trademarks enjoy substantial exposure among relevant purchasers or substantial sales to a significant percentage of the relevant market. The record also lacks any information regarding consumer perception from which we can conclude that opposer's mark is so well known that it can be considered famous.

enjoyed by the mark FREDERICK'S OF HOLLYWOOD does not extend to opposer's mark FREDERICK'S.

One test for determining the issue of likelihood of confusion is the similarity of the general commercial impressions engendered by the marks. Considering this issue, first, in relation to opposer's mark FREDERICK'S,¹² we find that the obvious similarities between FREDERIQUE and FREDERICK'S outweigh the differences between these two marks, leading us to conclude that the commercial impressions of these two marks are substantially similar and, in connection with the identical and closely related goods in this case, confusion as to source or sponsorship is likely. This is particularly true in view of the fact that, due to the consuming public's fallibility of memory, we concern ourselves with the likely recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975).

While applicant has argued that its mark is distinguished by the persona of Ms. van der Wal, we note

¹² We note that the design element of the FREDERICK'S mark in opposer's Registration No. 664,746 is minimal and, thus, we focus our analysis on the word portion of the mark.

that, regardless of whatever renown Ms. van der Wal may enjoy among relevant purchasers, we must consider the issue of likelihood of confusion in relation to the applied-for mark, which is the word FREDERIQUE alone. Similarly, we find the limited number of third-party registrations incorporating the name "Frederick" to be inapposite, as each registered mark includes at least one additional word or name, unlike the case before us where applicant's mark is merely the feminine form of the name "Frederick." We find the possessive form of opposer's mark to be an insignificant distinction.

Considering, next, opposer's mark FREDERICK'S OF HOLLYWOOD, we note that the "OF HOLLYWOOD" portion of the mark, while by no means insignificant, is a phrase modifying the dominant term "FREDERICK'S." We find the commercial impression of applicant's mark FREDERIQUE to be sufficiently similar to the commercial impression of opposer's FREDERICK'S OF HOLLYWOOD mark that their contemporaneous use in connection with the goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Applicant points to a lack of actual confusion and opposer concedes that it is aware of no instances of actual confusion. However, applicant's mark is the subject of an

intent-to-use application and applicant's evidence of use is fairly limited. Thus, it is not clear what opportunities have existed for confusion to occur. While, concurrent use of confusingly similar marks over a period of time in the same geographic area without any evidence of actual confusion may weigh against a holding of likelihood of confusion, actual confusion is not necessary to a finding of likelihood of confusion. See, *G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990).

Finally, we note that it is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The opposition is sustained and
registration to applicant is refused.

G. D. Hohein

B. A. Chapman

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board